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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,810	01/30/2001	Bart Victor	3977-8	1008

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EXAMINER	
FERNSTROM, KURT	

ART UNIT	PAPER NUMBER
3712	4

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/772,810	VICTOR ET AL.
	Examiner	Art Unit
	Kurt Fernstrom	3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. Claim 14 is objected to because of the following informalities: "principals" should be "principles". Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed towards a method of fostering thinking, comprising performing various steps in an attempt to enhance or facilitate discussion concerning the thoughts of various participants of a meeting, which is not patentable subject matter.

The Federal Circuit has applied the practical application test to determine whether claimed subject matter is patentable under 35 USC 101. *ATT Corp. V. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. V. Signature Financial Group Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998). The test for practical application requires that a "useful, concrete and tangible result" be accomplished. The present invention does not meet the last two requirements of the test, that

is; it does not produce a result which is concrete or tangible. The thoughts of a person are subjective and indefinite, and not tangible or concrete. While the physical models being created as part of the method are themselves "tangible" and "concrete", the test for determining patentability concerns whether the results of a method are tangible and concrete.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Because the invention does not produce a concrete or tangible result for the reasons discussed above, the invention cannot operate as intended without undue experimentation.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention. The claims contain several examples of language which is overly vague and broad, such that the scope of the invention is defined with sufficient particularity. Fr example, it is not clear how the invention is defined by such phrases as "to serve as physical metaphors" (claim 1), "relating to aspects of the topic" and "how the features of the model relate to the topic" (claim 1), "involves" and "business planning" (claim 2), "represents" and "an aspect" (claim 3), "how that relates to how the company and its customer interact" (claim 4), "how to address changes in how the company and its customer interact" (claims 5, 6 and 14), "represent" (claim 9) and "representing guiding princip[le]s" (claim 14).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corporage Games Creative Team Building Events ("Corporage"). Corporage discloses on page 2 a method of fostering thinking associated with a selected topic relating to the business world wherein several of the group of activities to be selected comprise creating a physical model, including Design and Construction games, Jigsaw Puzzle events and various artistic challenges, including painting, sculpting, video, music, photography, etc. Corporage further discloses that discussions

among the group are conducted to discuss the events that were performed, as part of a "debriefing" session. Corporage also discloses on page 1 that the event may relate to a theme selected from a wide range of possibilities (see bulletpoint #5). Specific themes, including bringing a group together, encouraging a group to work more closely together, communication and customer service, are discussed on page 1. A presentation portion presenting the objectives of an activity is also inherent in any team building exercise. While Corporage does not explicitly disclose that the models constructed serve as physical metaphors, such a step would have been obvious for the purpose of creating models which relate to a given theme, in light of the fact that Corporage discusses various events which are tied in to a selected theme. Also, "to serve as physical metaphors" is considered to be functional language, which describes the intended purpose of the method rather than explicitly defining any concrete method steps, and thus is deemed to have little if any patentable weight. With respect to claim 2, "business planning" is a broad term, and is disclosed, or at the least suggests, by the various themes discussed by Corporage. With respect to claims 3, 4, 9 and 14, the representations of an "aspect" of the company and a customer are suggested by Corporage, in particular the discussion of communication and customer service. With respect to claims 5, 6 and 13, the debriefing portion of the method disclosed by Corporage suggests the various types of discussions claimed. With respect to claims 7 and 8, the types of blocks disclosed are well known, and their use would have been obvious, particularly in a design or construction game. With respect to claims 10-12, it is well known in construction kits, particularly in the Lego type of building blocks, to construct both

predefined sets and creative models, and it is also known with this type of building block to reuse the blocks to create different types of models. It is also well known, regarding claim 11, in modeling systems to start with a predefined model as an introduction to the system before moving on to more creative endeavors.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Roberts, Torres, Hoo, Smith and "Promoting New Methods" disclose various business training systems. Duggan discloses a construction toy which may be used to teach cooperation and teamwork.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303.

KF

Kurt Fernstrom

May 15, 2003